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EXAMINER

ZURITA, JAMES H

ART UNIT PAPER NUMBER

3625

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/801,613
Filing Date: March 08, 2001
Appellant(s): WIESEHUEGEL ET AL.

Robert H. Frantz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 23 February 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-23 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

20020059131

Goodwin et al.

05-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodwin et al., US Patent Application Publication US 2002/0059131. This rejection is set forth in a prior Office Action, mailed on 23 November 2004.

(11) Response to Argument

Appellant argues that Goodwin's seller profile is not controlled by a pre-existing contract between an offeror and a broker. However, the Examiner notes claim 1 reads:

...said entitlement definitions being determined by and controlled by a previously established reseller contract **between an offeror and a guest auction participant** in a manner which prevents a guest auction participant from modifying the entitlement schema; (emphasis added)

A reseller is one who resells; to resell is to sell again, usually to a new party.¹ A purchaser can be a reseller, as Goodwin discloses:

For example, this data can be original Financial product data or updates to Financial product data (if the **Seller resells the Financial product**). One reason for providing this material is so that the system (and/or an Analyst) can assemble a Detailed Summary

¹ MERRIAM WEBSTER'S Collegiate Dictionary.

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Document after a request to do so is received from the Seller. (page 9, table 1, emphasis added)

[0122] In one embodiment, the data uploaded to the site is in PDF format files built from Microsoft Word and Microsoft Excel templates downloaded from the system 30. For example, this data can be original financial product data or updates to financial product data (if the **Seller 102 resells the financial product**). (Emphasis added)

A contract is a binding agreement between two or more persons or parties.²

Goodwin discloses resellers and pre-existing agreements. For example:

[0111] ...The **profile** of a Seller 102, in one embodiment, also stores other information provided by a Seller 102, such as preferences, criteria for accepting bids, restrictions on bids (e.g., certain users may be prohibited from bidding), restrictions on access to information (**bidders may be required to sign on and/or acknowledge specific conditions BEFORE receiving information**), specification of type of bidding to occur (e.g., type of auction), **permission for the system 30** to accept bids on behalf of the Seller 102, etc. This type of information also can be provided in the forms 282, 284, 286, 288. Goodwin, paragraph 111, emphasis added

[0070] User Management 40 is a subsystem providing user management functions for users of the system 30. These users, in at least one embodiment, can be sellers and potential sellers of financial products, buyers and potential buyers of financial products, so-called **market observers** (users who **can view** the transactions occurring on the site and/or the financial products available on the site, **but who are not necessarily participating in any transactions**), **visitors**, **"guest" users**, **auditing personnel**, etc. For example, in at least one embodiment, the User Management 40 subsystem provides interface to data such as user **profile** data, user preference data, stored search/**filter results**, lists of financial products for which a user has purchased due diligence or other information, a user registration component to handle **initial site registration**, login/authentication functions, an interface that allows a system administrator or quality control person **to "activate" the ability for a Buyer or Seller to conduct transactions, and the like**.

Thus, guest profiles are controlled by pre-existing contracts between offeror and guest. Goodwin discloses agreements that are binding, in that a guest is able to view certain information if he accepts, signs on and/or acknowledge specific conditions **before** receiving information.

As previously noted, Goodwin does not use *Appellant's* label "...**previously-established reseller contract**..." However, the labels given to various actors and

² Definition of contract, MERRIAM WEBSTER'S Collegiate Dictionary.

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modules do not move to impact either the elements of the system or the steps of the method in any way which provides the patentable moments necessary in distinguishing the instant system and method from that of Goodwin.

In response to Appellant's arguments concerning disclosures in Goodwin, the fact that Appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Appellant argues that Goodwin fails to recognize problems allegedly solved by appellant. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves *or in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


May 24, 2005

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